

Application Serial No. 09/991,503
Attorney Docket No. 08477.0099USC2
Reply to Office Action of October 17, 2005

REMARKS

The Non-Final Office Action (hereinafter the Action) mailed October 17, 2005 has been reviewed and these remarks are responsive thereto. Claims 41-63 remain pending in this application and currently stand rejected.

Claim Rejections Under 35 U.S.C. §103

The Action rejected claims 41-53 and 55-63 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,331,546 to Webber, *et al.* (hereinafter *Webber*) in view of the article Which Frequent-Flier Program? (Airlines promise free travel, but their delivery record has been spotty. We identify the better programs.) Consumer Reports Travel Letter: vol. 6, no. 10, pp 112-116, October 1990. Dialog file 646; #00500249 (hereinafter *Which Frequent-Flier Program*).

Claim 41

Claims 41 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Webber* in view of *Which Frequent-Flier Program*. Specifically, regarding claim 41, the Action states:

As per claim 41, Webber teaches:

A computerized incentive system for awarding credits to persons who book travel-related reservations, the system comprising:

- (a) a computerized reservation system connected to a network;
- (b) an interface device connected to the network and configured so that a user of the interface device has access to the computerized reservation system (see column 4, lines 5-25);
- (c) a reservation facility computer system connected to the network and thereby accessible to the user accessing the computerized reservation system, the reservation facility computer system configured so that the user may book a travel-related reservation (see column 6, line 65-column 7, line 3; column 16, line 42-column 17, line 5);
- (d) a conversion system connected to the network configured to facilitate communications between the computerized reservation system and the computerized reservation system (see figure 1, item 26; see column 16, lines 41-60);

Webber fails to teach:

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(c) an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred. However, the article Which frequent-Flier Program discloses about frequent-flier programs where people can earn credits in various ways, such as flying, staying at hotels, renting cars and use it for variety of awards (see paragraphs 5, 6, 9, 11, 17, and 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Webber's system would use the travelers' frequent flier numbers (see Webber column 17, lines 15-20; figure 8B, item 326) to provide said travelers with offers or awards from different service providers which have frequent fliers programs, as taught by the Frequent-Flier program (see Frequent flier paragraph 54; "car rental", "Hotel"). The Webber's system would be motivated to link his system to the frequent flier programs of different service providers in order to allow frequent fliers member to use the Webber's system to find not only an itinerary-with-fare combinations acceptable in terms of cost and convenience to said members buy also the travel offers that let said members earn the most credits and/or awards in various way (i.e. such as flying, staying at hotels, renting cars, etc).

Applicant respectfully traverses the Action's rejection. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir 1999); *In re Rouffer*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

The references used in the Action fail at least the third prong of obviousness. Claim 41 is patentably distinguishable over the cited art for at least the reason that it recites, *inter alia*, an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred.

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In contrast, per Action's admission, "Webber fails to teach: (e) an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred." For example, Webber discloses a trip planner for optimizing travel itinerary selection conforming to individualized travel policies. In Webber, the verification that an event relating to the travel-related reservation has occurred does not happen; rather, a travel itinerary is formed conforming to individualized travel policies.

In addition, Frequent-Flier program does not overcome Webber's deficiencies. Frequent-Flier program merely discloses a comparison of 12 programs as currently operated by 13 major US airlines and how well Consumer Report Travel Letter readers think these programs deliver on their promises, based on data from Consumer Report Travel Letter own survey. (Frequent-Flier program paragraph 2). Like Webber, Frequent-Flier program at least does not teach or suggest the verification that an event relating to the travel-related reservation has occurred.

Combining Webber with Frequent-Flier program would not have led to the claimed invention because Webber and Frequent-Flier program, either individually or in combination, at least do not disclose or suggest the verification that an event relating to the travel-related reservation has occurred, as recited by Claim 41. Accordingly, independent Claim 41 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 41.

Furthermore, the references cited in the Action fail the first prong of obviousness in that some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings. The Action states:

Which frequent-Flier Program discloses about frequent-flier programs where people can earn credits in various ways... Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Webber's system would use the travelers' frequent flier numbers ... to provide said travelers with offers or awards from different service providers which have frequent fliers programs, as taught by the Frequent-Flier

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program ... *The Webber's system would be motivated to link his system to the frequent flier programs of different service providers in order to allow frequent fliers member to use the Webber's system to find not only an itinerary-with-fare combinations acceptable in terms of cost and convenience to said members buy also the travel offers that let said members earn the most credits and/or awards in various way ...*

Simply because both Webber and Frequent-Flier program mention the use of frequent flier members does not provide motivation to combine the two references, nor does it render Applicants' invention obvious. MPEP §§2143.01(III) and (IV) state:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) ... Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.) Emphasis Added.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). Emphasis Added.

While Applicants are not admitting that Webber and Frequent-Flier program teach all aspects of the claimed invention, even if they did there is no motivation to combine the references. As the MPEP states, absent language in the references of the desirability of the combination, the mere fact that the references can be combined does not render the resultant combination obvious. A statement of "it would have been obvious to a person of ordinary skill in the art at the time the application was made ..." is insufficient of overcome the lack of suggestion and/or motivation in the references to combine said references.

Lastly, should the Examiner find the above arguments unpersuasive, Applicants' have further amended claim 41 to further include a conversion system connected to the network

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configured to facilitate communications between the computerized reservation system and the computerized reservation system, wherein the conversion system receives an availability format and then converts the travel-related reservation contained within the availability format into a standard format, which is taught by neither Webber or Frequent-Flier program. Support for this Amendment can be found in Applicants' original disclosure page 6, lines 10-32. Regarding the Action's remarks that Webber teaches a conversion module at figure 1, items 26; column 16, lines 41-60, Applicants' submit that item 26 in figure 1 is disclosing communications protocol converters such as modems and/or LAN connections (see Webber column 5, lines 26-33). In column 16, lines 41-60, Webber discloses that the Webber system "sells flights using the appropriate airline reservation system format." Webber does not contemplate having multiple availability formats and "a conversion system connected to the network, wherein the conversion system receives an availability format and then converts the travel-related reservation contained within the availability format into a standard format." Webber discloses that every reservation system has a standard format and the travel-related reservation must be entered in said standard format as indicated by the language "sells flights using *the appropriate airline reservation system format*."

Claim 47

Claims 47 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Webber* in view of *Which Frequent-Flier Program*. Specifically, regarding claim 47, the Acton states:

As per claim 47, Webber teaches:

A computer implemented method of awarding credits to person who book travel-related reservations, the method comprising:

(a) transmitting travel-related reservation information from a user via an interface device connected to a network to a computerized reservation system connected to the network (see column 4, lines 9-25);

(b) converting the travel-related reservation information into a format acceptable by a selected reservation facility computer system (see column 16, lines 41-60);

(c) communicating the travel-related reservation information to a reservation facility computer system connected to the network (see column 4, lines 9-25);

Webber fails to teach:

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(d) communicating the travel-related reservation information to an awards system, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked upon verification that an event relating to the travel-related reservation has occurred. However, the article Which frequent-Flier Program discloses about frequent-flier programs where people can earn credits in various ways, such as flying, staying at hotels, renting cars and use it for variety of awards (see paragraphs 5, 6, 9, 11, 17, and 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Webber's system would use the travelers' frequent flier numbers (see Webber column 17, lines 15-20; figure 8B, item 326) to provide said travelers with offers or awards from different service providers which have frequent fliers programs, as taught by the Frequent-Flier program (see Frequent flier paragraph 54; "car rental", "Hotel"). The Webber's system would be motivated to link his system to the frequent flier programs of different service providers in order to allow frequent fliers member to use the Webber's system to find not only an itinerary-with-fare combinations acceptable in terms of cost and convenience to said members buy also the travel offers that let said members earn the most credits and/or awards in various way (i.e. such as flying, staying at hotels, renting cars, etc).

Applicant respectfully traverses Action's rejection and request withdrawal of said rejection. See arguments for claim 41, *supra*, in support of allowance.

Claim 53

Claims 53 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Webber* in view of *Which Frequent-Flier Program*. Specifically, regarding claim 53, the Action states:

As per claim 53, Webber teaches:

A computer implemented method of awarding credits to persons completing travel-related purchases, the method comprising:

(a) transmitting a purchaser identification code and travel-related purchase information via an interface system configured to covert the travel-related purchase information into a reservation system format of a selected reservation system, said interface system connected to a network to an award system connected to the network upon the completion of a travel related purchase (see column 4, lines 9-25);

Webber fails to teach:

(b) processing of the travel-related purchase information by the award system to verify that the travel-related purchase is complete and calculate the credits to be assigned to the person completing the travel-related purchase; and

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(c) assigning the calculated credits to the person completing the travel-related purchase, wherein the credits assigned may be exchanged for an award.

However, the article Which frequent-Flier Program discloses about frequent-flier programs where people can earn credits in various ways, such as flying, staying at hotels, renting cars and use it for variety of awards (see paragraphs 5, 6, 9, 11, 17, and 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Webber's system would use the travelers' frequent flier numbers (see Webber column 17, lines 15-20; figure 8B, item 326) to provide said travelers with offers or awards from different service providers which have frequent fliers programs, as taught by the Frequent-Flier program (see Frequent flier paragraph 54; "car rental", "Hotel"). The Webber's system would be motivated to link his system to the frequent flier programs of different service providers in order to allow frequent fliers member to use the Webber's system to find not only an itinerary-with-fare combinations acceptable in terms of cost and convenience to said members buy also the travel offers that let said members earn the most credits and/or awards in various way (i.e. such as flying, staying at hotels, renting cars, etc).

Applicant respectfully traverses Action's rejection and request withdrawal of said rejection. See arguments for claim 41, *supra*, in support of allowance.

Claim 59

Claims 59 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Webber* in view of *Which Frequent-Flier Program*. Specifically, regarding claim 59, the Action states:

As per claim 59, Webber teaches:

A computerized incentive system for awarding credits to persons who book travel-related reservations, the system comprising:

(a) an interface system connected to the network (see column 4, lines 9-25) wherein said interface system is configured to convert reservation information into a reservation facility data format of a designated reservation facility (see column 16, lines 42-55);

(b) a reservation facility computer system connected to the network and configured so that a user of the interface device may access the reservation facility computer system to book a travel-related reservation (see column 4, lines 9-25);

Webber fails to teach:

(c) an award system connected to the network, the award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation

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has been booked, the award system being further configured to verify fulfillment of the travel-related reservation and decrement credits previously assigned to the person for travel-related reservation that are not fulfilled. However, the article Frequent-Flier teaches a frequent-flier system that keeps a running account of miles earned and credits and decrements credits from the user's account accordingly (see paragraph 11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a customer would use the Webber computerized system to book travel reservation and would use the Frequent-Flier program taught by the above article, to earn credits or Frequent-Flier points for miles flown or purchases made through partners airlines, car-rental companies, hotel chains, and credit-cards. The awarding of credits for travel-related purchases would help customers lower their travel expenses. It would be obvious that the system would check if the travel-related reservation was fulfilled because there would be no purpose of giving a credit award to someone that never bought the travel-reservation. If the system does not verify if the person fulfilled the travel-related reservation then people would receive credits for cancel reservations and would be able to redeem the credits for awards, making the system useless.

Applicant respectfully traverses Action's rejection. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates "the prior art references must teach or suggest all claim limitations." *Id.* The references used in the Action fail in that neither Webber, Which Frequent-Flier Program, nor a combination of the two teach an "award system being configured to receive data concerning the travel-related reservation, wherein the award system assigns credits to a person for whom the travel-related reservation has been booked, the award system being further configured to verify fulfillment of the travel-related reservation and decrement credits previously assigned to the person for travel-related reservation that are not fulfilled."

Regarding Action's remark "article Frequent-Flier teaches a frequent-flier system that keeps a running account of miles earned and credits and decrements credits from the user's account accordingly" (see paragraph 11). Applicants submit that paragraph 11 is disclosing a system that simply "keeps a running account of the miles a consumer earns and issues periodic statements." Furthermore, paragraph 11 only discloses that when travel has been arranged "mileage for and *award*, the *credit* is deducted from your balance." There is no teaching or

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suggestion as to verify fulfillment of the travel-related reservation and decrement credits previously assigned to the person for travel-related reservation that are not fulfilled.

Examiner states:

It would be obvious that the system would check if the travel-related reservation was fulfilled because there would be no purpose of giving a credit award to someone that never bought the travel-reservation. If the system does not verify if the person fulfilled the travel-related reservation then people would receive credits for cancel reservations and would be able to redeem the credits for awards, making the system useless."

Applicant disagrees with this statement. If Examiner continues to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed.Cir 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002) (stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

Claim 62

Claims 62 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Webber* in view of *Which Frequent-Flier Program*. Specifically, regarding claim 62, the Action states:

Claim 62 contains the same limitations as claims 41 and 44, therefore the same rejection is applied.

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Applicant respectfully traverses Action's rejection. Argument for claim 41, *supra*, is hereby incorporated by reference. Regarding claim 44, see argument for claim 44, *infra*.

Claim 42-46, 48-52, 55-58, 60-61 and 63

Regarding claim 42-46, 48-52, 55-58, 60-61 and 63, Applicant submits that claims 42-46, 48-52, 55-58, 60-61 and 63 are in condition for allowance by virtue of its dependency on amended claims 41, 47, 53, 59, and 62. MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully request withdrawal of the rejections to claims 42-46, 48-52, 55-58, 60-61 and 63. Regarding the Action's additional assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above comments and the amendment to the claims.

Claim 54

The Action rejected claim 54 under 35 U.S.C. § 103(a) as being unpatentable over *Webber* in view of the article *Which Frequent-Flier Program* and further in view of U.S. Patent No. 6,094,640 to Goheen (hereinafter *Goheen*).

Regarding claim 53, Applicant submits that claim 54 is in condition for allowance by virtue of its dependency on amended claim 53. *Id.* Accordingly, Applicant respectfully request withdrawal of the rejection to claim 54. Regarding the Action's assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above comments and the amendment to the claims.

Accordingly, in view of the above arguments, Applicant respectfully submits that claims 41-63 are in condition for allowance.

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CONCLUSION

Applicants respectfully request that this Amendment be entered by the Examiner, placing the claims in condition for allowance. Applicants respectfully submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the *Action*, since all of the elements and their relationships claimed were earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants respectfully submit that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants respectfully submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The preceding arguments are based only on the arguments in the *Action*, and therefore do not address patentable aspects of the invention that were not addressed by the *Action*. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the *Action* contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization set forth in the *Action*. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to Deposit Account No. 13-2725.


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Respectfully submitted,

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